

REMARKS

Claims 14-19 and 21-22 are pending. By this Amendment, claims 1-13 and 20 are canceled and Figs. 4, 5, 9 and 11 are corrected by the attached Request for Approval of Drawing Corrections. Reconsideration based on the above amendments and following remarks is respectfully requested.

The attached Appendix includes marked-up copies of each rewritten paragraph (37 C.F.R. §1.121(b)(1)(iii)) and claim (37 C.F.R. §1.121(c)(1)(ii)).

I. Drawing Objections are Obviated

In paragraph 3, the Office Action objects to Figs. 4, 5, 9 and 11. As set forth in the attached Request for Approval of Drawing Corrections, the proposed corrections to Figs. 4, 5, 9 and 11 obviate the drawing objection. Withdrawal of the objection to Figs. 4, 5, 9 and 11 is respectfully solicited.

II. Claims 1-13 and 20 are Canceled Without Prejudice or Disclaimer

The Office Action rejects claims 1, 12, 13 and 20 under 35 U.S.C. §102(b) over WO 97/10668 to Kulakowski; rejects claim 2 under 35 U.S.C. §103(a) over Kulakowski in view of U.S. Patent 6,061,718 to Nelson; rejects claims 3-9 under 35 U.S.C. §103(a) over Kulakowski in view of Nelson and U.S. Patent 6,212,535 to Weikart et al. (hereinafter "Weikart"); rejects claim 10 under 35 U.S.C. §103(a) over Kulakowski in view of Weikart; and rejects claim 11 under 35 U.S.C. §103(a) over Kulakowski in view of U.S. Patent 5,247,591 to Baran. Claims 1-13 and 20 are canceled without prejudice or disclaimer. Thus, these rejections are moot.

III. Claims 14, 16-19 and 21 Define Allowable Subject Matter

The Office Action rejects claims 14 and 16-19 under 35 U.S.C. §102(e) over U.S. Patent 5,978,837 to Foladare et al. (hereinafter "Foladare"), and rejects claims 14 and 21 under 35 U.S.C. §102(e) over U.S. Patent 5,805,298 to Ho et al. (hereinafter "Ho"). The rejections are respectfully traversed.

Claims 14 and 21 relate to a facsimile device. When the facsimile device receives electronic mail data attached with an electronic mail title, the electronic mail title is displayed on a title displaying means. An image is formed based on electronic mail data that is selected based on the electronic mail title.

On the other hand, according to Ho, the communication device 100 shown in Fig. 1 can transmit and receive e-mail messages to and from the mailbox 105. When the communication device 100 accesses the mail box 105, a list (data) of e-mail messages stored in the mailbox 105 is displayed. The list may be printed out if desired. Then, one or more e-mail message selected by the user is retrieved from the mail server 105 and printed out (col. 8, lines 18-43).

However, according to claims 14 and 21, a title of e-mail message that has been received by the facsimile device is displayed. Contrarily, a list is first retrieved and displayed and then only a selected e-mail message is retrieved and printed according to Ho. Thus, claims 14 and 21 differ from the teaching of Ho.

Claims 14 and 21 of the present Application have at least the following advantages over the configuration of Ho.

According to Fig. 4 of Ho, the communication between the mail server and the computer is maintained until the operation completes after the determination of whether printing or deletion of the message is necessary (col. 8, lines 7-76). Accordingly, if the user

takes a relatively long time duration for selecting messages to printout and delete, the communication time between the mail server 110 and the device 100 is prolonged. This may increase a burden on the mail server and also communication costs for the user in Ho.

Furthermore, in Ho, the mail server 110 needs to perform data search and data generation for sending list data. The burden on the server 110 increases in this manner also. Moreover, in order to send and delete only selected messages in accordance with instruction from the communication device 100, the managing control for the stored messages may become complex, requiring additional control programs or devices in the server 110. This also increases the burden on the server 110, which makes it difficult for the system to handle a large number of clients (communication devices).

On the other hand, according to the configuration of the claimed invention, no additional burden is placed on the server. Also, the communication duration, i.e., communication costs, is unchanged, and there is no need to provide any additional programs or devices to the server. Accordingly, the system structure is not limited.

Foladare relates to a system that forwards messages to destinations selected based on alert signals 245. More specifically, the E-Mail server 60 buffers e-mail messages sent to a recipient (computer 70), and sends the alert signal 245 to the computer 70 or the mobile pager 74. The recipient reviews the alert signal and selects a forwarding destination. Then, the server 60 forwards the e-mail message to a selected destination (col. 3, lines 3-25). The selection of forwarding destination could be automatically performed according to an embodiment disclosed in col. 4, line 7.

With Foladare, the E-Mail server 60 forwards a message to a selected destination, but does not form an image based on a message. Although the computer 70 or the mobile pager 74 displays the received alert signals 245, they do not display the electronic mail title that has been received along with the electronic mail data, and does not form an image based on electronic mail title selected from the received messages.

Regarding claim 17, the Office Action asserts that Foladare discloses all of the features of claim 17. However, Applicant respectfully submits that Foladare discloses that e-mail message is forwarded to a selected destination (col. 3, lines 11-25), but does not disclose the feature of forming images based on high priority messages, as recited in claim 17. Thus, Foladare does not disclose all of the features of claim 17.

Regarding claim 18, the Office Action asserts that Foladare discloses all of the features of claim 18. However, Applicant respectfully submits that Foladare does not disclose any image forming means that forms images based on e-mail data. Rather, Foladare is a pager card 71 based alert signal 245' system (col. 4, lines 37-62) requiring a separate priority word list 752 search at a different receipt's computer 70 using a priority word comparison program 726. Foladare does not function to form images based on e-mail data.

In view of the above, Foladare does not disclose all of the features recited in claims 16 and 19 for the reasons discussed with respect to claims 14, 17-18 and 21 and for the additional features recited therein. Withdrawal of the rejections of claims 14 and 16-19 under 35 U.S.C. §102(e) over Foladare and claims 14 and 21 under 35 U.S.C. §102(e) over Ho is respectfully requested.

IV. Claims 15 and 22 Define Allowable Subject Matter

The Office Action rejects claim 15 under 35 U.S.C. §103(a) over Ho in view of WO 97/10668 to Kulakowski, and rejects claim 22 under 35 U.S.C. §103(a) over Ho in view of Foladare. These rejections are respectfully traversed.

As discussed above, Ho and Foladare do not teach, disclose or suggest displaying an electronic mail title that has been received along with an electronic mail data and forming an image based on electronic mail title selected from the received messages as recited in claim 14 and 21. Likewise, Kulakowski also does not teach, disclose or suggest displaying an electronic mail title that has been received along with an electronic mail data and forming an image based on electronic mail title selected from the received messages, as recited in claim 14. Claim 15 depends from claim 14 and claim 22 depends from claim 21. Thus, a combination of Ho and Kulakowski does not teach, disclose or suggest all of the features of claim 15 and a combination of Ho and Foladare does not teach, disclose or suggest all of the features of claim 22.

For at least these reasons, Ho, Foladare and Kulakowski, individually or in combination do not teach, disclose or suggest all of the features recited in claims 15 and 22. Thus, the combination of Ho and Kulakowski and Ho and Foladare do not render obvious the subject matter of those claims for the reasons discussed and withdrawal of the rejections of claim 15 under 35 U.S.C. §103(a) over Ho in view of Kulakowski and claim 22 under 35 U.S.C. §103(a) over Ho in view of Foladare is respectfully solicited.

V. Conclusion

For at least these reasons, it is respectfully submitted that this application is in condition for allowance. Reconsideration of the application is requested.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Richard J. Kim
Registration No. 48,360

JAO:RJK/sld

Attachments:

Appendix
Request for Approval of Drawing Corrections

Date: April 23, 2002

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--

APPENDIX

Changes to Specification:

Page 9, line 9 is corrected as follows:

{0065}

Changes to Claims:

Claims 1-13 and 20 are canceled.